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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,190	03/29/2001	Martin A. Kenner	56096US002	4518

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EXAMINER

OSMAN, RAMY M

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,190

Applicant(s)

KENNER ET AL.

Examiner

Ramy M. Osman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to amendment filed on 3/3/2005. Claims 1-42 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 5 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant states that the method "is performed without identifying the content recipient to the content provider". The specification merely repeats this language on page 29 lines 5-10, and fails to further explain how a client can request something without identifying itself. A client request inherently involves some sort of identification. Internet request packets include source and destination IP address fields. It is therefore seen that the source (i.e. content recipient) is identified. To anonymize this identification, a method or protocol is necessary to accomplish it. Applicant fails to detail this feature.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-8,10-13,18-22,30-34 and 37 rejected under 35 U.S.C. 102(b) as being anticipated by over Mano et al (US Patent No 5,978,807).**

6. In reference to claims 1,18 and 32, Mano teaches a method performed at a content recipient, and a computer readable storage comprising:

executing first program code at the content recipient so as to identify a content provider having posted content of interest to the content recipient (column 2 lines 37-56 and column 4 lines 15-33,46-53 & 65-67); and

executing second program code at the content recipient so as to automatically initiate a request for the posted content (column 2 lines 37-56 and column 5 lines 2-23).

7. In reference to claim 2,4,6,8 and 33, Mano teaches the method and computer readable storage of claims 1 and 32 further comprising canceling future requests for the posted content without communicating such an intent to the content provider (Summary and column 4 lines 15-33,46-53 & 65-67, Since Mano teaches that a user can input an address for automatic download, then it is inherent that the user can also delete that entry if the user decides not to retrieve downloads anymore).

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8. In reference to claim 3,7,26,28 and 34, Mano teaches the method and computer readable storage of claims 1,18 and 32 wherein the executing of the second program code at the content recipient so as to automatically initiate a request for the posted content comprises executing second program code at the content recipient so as to automatically and recurrently initiate requests for the posted content (column 2 lines 37-56 and column 5 lines 2-23).

9. In reference to claims 5,27 and 35, Mano teaches the method and computer readable storage of claims 1,18 and 32, wherein the method is performed without identifying the content recipient to the content provider (column 2 lines 37-56).

10. In reference to claims 10,12,19,20,21,30,31 and 36, Mano teaches the method and computer readable storage of claims 1,18 and 32 further comprising executing third program code at the content recipient so as to receive the posted content at the content recipient in response to execution of the second program code (column 5 lines 2-45).

11. In reference to claims 11,13,22 and 37, Mano teaches the method and computer readable storage of claims 12,18 and 36 further comprising executing fourth program code at the content recipient so as to provide notice to the content recipient that the posted content has been received at the content recipient in response to execution of the second and third program code, wherein the notice is displayed even if the session is active (column 4 lines 30-50 and column 5 lines 10-45, Mano discloses providing date and time notice of downloads).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 9 and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Mano et al (US Patent No 5,978,807) in view of Chang et al (US Patent No 6,134,584).**

14. In reference to claims 9 and 29, Mano teaches the method and computer readable storage of claims 1 and 18. Mano fails to explicitly teach providing notice to the content recipient that no posted content has been received by the content recipient in response to execution of the second program code. However, Chang teaches scheduling data download from a server over a network. Chang discloses retrieving data from a server and if the download is unsuccessful then an unsuccessful download message is generated for the user and an unsuccessful signal is generated to try another download attempt (column 5 lines 50-65 and column 6 lines 35-45).

It would have been obvious for one of ordinary skill in the art to modify Mano by providing notice to the content recipient that no posted content has been received by the content recipient in response to execution of the second program code as per the teachings of Chang for the purpose of alerting the user of an unsuccessful download and to try another download attempt.

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15. Claims 14 and 23 and rejected under 35 U.S.C. 103(a) as being unpatentable over Mano (US Patent No 6,167,567) in view of Beyda et al (US Patent No 6,636,965).

Mano teaches the method and computer readable storage of claims 13 and 22 above. Mano fails to explicitly teach wherein the notice is an icon. However, Beyda teaches recipients receiving electronic messages. Beyda discloses icons accompanying the messages for the purpose of alerting users of the message (Abstract and column 4 lines 10-20).

It would have been obvious for one of ordinary skill in the art to modify Mano by making the notice an icon as per the teachings of Beyda complete messages for the purpose of alerting users of the message.

16. Claims 15,16,24,25,38 and 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Mano (US Patent No 6,167,567) in view of Pike (US Patent No 4,555,775).

Mano teaches the method and computer readable storage of claims 13 and 37 above. Mano fails to explicitly teach wherein the method further comprises executing fifth program code at the content recipient so that, upon an action related to the notice, the posted content burns through the session so that the posted content is visible to a user; and comprises executing fifth program code at the content recipient so that, upon an action related to the notice, the posted content is displayed in front of the session so that the posted content is visible to a user. However, Pike teaches overlaying windows for multiple active programs. Pike discloses bringing a window layer to the front of all other layers so that the layer can then be visible to a user (column 2 lines 3-11 & 53-67 and column 10 lines 20-67).

It would have been obvious for one of ordinary skill in the art to modify Mano by bringing content to the front when a certain action occurs as per the teachings of Pike so that the content can be prioritized and made visible to the user.

17. Claims 17 and 40-42 rejected under 35 U.S.C. 103(a) as being unpatentable over Mano (US Patent No 6,167,567) in view of Kullick et al (US Patent No 5,732,275).

18. In reference to claims 17, 41 and 42, Mano teaches the method and computer readable storage of claims 1 and 32. Mano fails to explicitly teach electronically receiving the second program code at the content recipient from the content provider. However, Kullick teaches managing and updating programs. Kullick discloses programs that are provided by developers to clients and where the clients can download upgrades to the provided programs to keep them up-to-date (column 3 lines 44-65).

It would have been obvious for one of ordinary skill in the art to modify Mano by electronically receiving the second program code at the content recipient from the content provider as per the teachings of Kullick so that clients can download upgrades to the provided programs to keep them up-to-date.

19. In reference to claim 40, Mano teaches the method of claim 32 further comprising executing third program code at the content provider so as to determine whether the content recipient possesses the second program code and, if the content recipient does not possess the second program code, to download the second program code to the content recipient (Kullick, column 3 lines 44-65).

Response to Arguments

20. Applicant's arguments with respect to claims 1-42 have been considered but are moot in view of the new ground(s) of rejection.

21. Applicant's argument regarding the 112 first paragraph rejection is not persuasive.

Applicant failed to comment on the fact that a client is identified with an IP address and there is no mention in the specification as to how one would anonymize the client.

Applicant argues that "the web site does not require a user identification" and that the user is not required to provide username, email address, phone number, etc. However, this is an inherent feature of many web sites on the Internet and is interpreted to be inherent in the above references.

22. As to claims 15 and 16, the 112 second paragraph rejection is withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M. Osman whose telephone number is (571) 272-4008. The examiner can normally be reached on M-F 9-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMO

May 23, 2005


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